

## REMARKS

This is a full and timely response to the final Office Action mailed September 12, 2006. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### Present Status of Patent Application

Upon entry of the amendments in this response, claims 1, 3-18 and 22-24 remain currently pending in the present application. Specifically, claims 4, 6-9, 13-15, and 17 are original, unamended claims; claims 2, 19-21 are canceled; claims 5, 10-12, and 18 have been previously presented; claims 1, 3, and 16 have been currently amended with no introduction of new matter; and claims 22-24 newly submitted with no introduction of new matter. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### A. Claim Rejection under 35 U.S.C. § 103(a)

#### I. Statement of the Rejection

Claims 1, 3, 5-7, 9-15 and 17-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Raynal et al. ("Raynal") [US 6,643,389] in view of Bohn et al. ("Bohn") [US 6,207,945].

#### Response to the Rejection

The MPEP provides several guidelines for rejecting a claim under 35 U.S.C. 103(a). Specific reference is made to MPEP 706.2(j) *Contents of a 35 U.S.C. 103 Rejection*, which states in pertinent part:

To establish a *prima facie* case of obviousness, **three basic criteria must be met**. First, there must be **some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.  
(Emphasis added)

Applicants respectfully assert that the current rejection of claims 1, 3, 5-7, 9-15 and 17-21 is improper because the Office action fails to satisfy the requirements of MPEP 706.2(j) for

establishing a *prima facie* case of obviousness. Remarks related to specific claims are provided below.

### **Claim 1**

In rejecting claim 1, the Office action asserts that Raynal discloses all aspects of Applicants' claim 1, except for "a navigation array having a plurality of sensors of capturing navigation images and determining the movement along a first axis and a second axis that is perpendicular to the first axis." The Office action then goes on to assert that "Bohn discloses the deficient claim limitation" and justifies combining Raynal with Bohn because "they are from the same field of imaging reconstruction from sub-images" and further suggests that it would have been obvious to one of ordinary skill in the art to modify Raynal with Bohn so as "to obtain accurate position information."

Applicants respectfully traverse the Office action rejection of claim 1 for at least the reasons provided below.

The first criterion under MPEP 706.2(j) states that there must be some suggestion or motivation to combine reference teachings. Applicants respectfully assert that the motivation presented in the current rejection is improper. Specifically, it is improper to merely point to certain selected aspects of Raynal and Bohn and state that it would be logical to combine these two references because of a perceived advantage, when there is no proper motivation present in the cited prior art reference to motivate one of ordinary skill in the art to carry out such a modification. Such a motivation may be derived for instance, if Raynal indicated a shortcoming in his invention that affected accuracy. Raynal does not disclose such a shortcoming. Therefore, it is illogical to insist that one of ordinary skill in the art would modify Raynal to "obtain accurate position information."

It may be further relevant to point out that it is legally impermissible to utilize hindsight obtained via Applicants' own disclosure to assert that a combination of prior art references would be apparent to one of ordinary skill in the art.

In this matter, the Federal Circuit has ruled: Hindsight reconstruction is impermissible. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Furthermore, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fitch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992)."

For at least the reasons outlined above, Applicants respectfully assert that the rejection fails to satisfy the first criterion of MPEP 706.2(j) to establish a *prima facie* case of obviousness as required for a proper rejection under 35 U.S.C. §103(a). The rejection further fails to satisfy the third criterion for reasons described below.

The Office action alleges that Bohn discloses “a navigation array (i.e. 130) having a plurality of sensors of (sic) capturing navigation images [Figure 3] and determining the movement along a first axis (i.e. x-direction) and a second axis (i.e. y-direction) that is perpendicular to the first axis [Column 12, Lines 18-32].” This allegation is valid to the extent that Bohn does indeed use two axes to determine **the direction of movement**. Towards this end, a pertinent portion (col. 12, lines 21-27) of the cited section from Bohn is reproduced below for easy reference:

The y-direction 240 may consist of a positive y-direction 242 and a negative y-direction 244. The x-direction 250 may consist of a positive x-direction 252 and a negative y-direction 254. In the example described herein, the imaging device 100 will be placed in the positive y-direction 242 above the text 220 and will be moved in the negative y-direction 244 across the text 220.

In contrast, Applicants’ claim 1 pertains to a navigation engine configured for determining an **amount of movement** along two axes. Therefore, Applicants respectfully assert that the rejection fails to satisfy the third criterion of MPEP 706.2(j) (vis-à-vis the prior art references when combined must teach or suggest all the claim limitations).

Nonetheless, in the interests of moving forward prosecution, and also in order to clarify and emphasize this aspect, Applicants have opted to currently amend claim 1. Consequently, in light of the current amendment, it will be relevant to point out that Bohn does not disclose setting a “predetermined x unit value” and a “predetermined y unit value” and using these values to determine the amount of movement. Attention is respectfully directed to Applicant’s original specification (for example, FIGs. 8A-D and associated description) for further details.

It will be further relevant to point out that claim 1 has been additionally amended in order to address the Office action allegation that certain portions of the claim are defined in terms of function rather than structure. Currently amended claim 1 now includes the structural feature: a navigation engine **configured for...** As is known, this structural definition is in line with conventional claim drafting practice as evidenced in numerous issued patents.

In summary, for at least the reasons cited above, Applicants respectfully assert that the rejection of claim 1 (as previously presented) is improper because the Office action fails to establish a *prima facie* case of obviousness that satisfies MPEP 706.2(j) for a proper rejection under 35 U.S.C. §103(a). Furthermore, Applicants respectfully submit that currently amended claim 1 is allowable for several additional reasons. Therefore, Applicants hereby request withdrawal of the rejection, followed by allowance of claim 1.

**Claims 3, 5-7, 9-15 and 17-18**

Because independent claim 1 is allowable, claims 3, 5-7, 9-15 and 17-18 that depend directly or indirectly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request allowance of claims 3, 5-7, 9-15 and 17-18.

**Claims 19-21**

Applicants have currently canceled claims 19-21 without prejudice, waiver or disclaimer and respectfully submit that the rejection of these claims has been thereby rendered moot.

**II. Statement of the Rejection**

Claims 1 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Raynal et al. (“Raynal”) [US 6,643,389] in view of Blalock et al. (“Blalock”) [US 5,729,008].

**Response to the Rejection**

**Claim 1**

Applicants have provided above, certain remarks related to MPEP 706.2(j) in response to the Office action rejection of claim 1 using the combination of Raynal and Bohn. These remarks are equally pertinent to the rejection of claim 1 using the combination of Raynal and Blalock. However, in the interests of brevity, Applicants have opted to refrain from repeating the remarks. Nonetheless, a couple of remarks that are specifically directed at this rejection will be outlined below.

Applicants respectfully traverse the Office action justification for combining Raynal with Blalock, i.e.: “because they are from the same field of imaging reconstruction from sub-images” and also that it would have been obvious to one of ordinary skill in the art to modify Raynal with Blalock so as “to obtain three degrees of freedom.” As remarked above, “the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fitch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).” In this case, Applicants respectfully submit that the Office action has failed to disclose a proper motivation or suggestion to modify Raynal with Blalock.

For at least this reason, Applicants respectfully assert that the rejection fails to satisfy the first criterion of MPEP 706.2(j). The rejection further fails to satisfy the third criterion because the cited prior art combination fails to at least disclose a navigation engine configured for determining “an amount of movement” along two axes.

In summary, for at least the reasons cited above, Applicants respectfully assert that the rejection of claim 1 (as previously presented) is improper because the Office action fails to establish a *prima facie* case of obviousness that satisfies MPEP 706.2(j) for a proper rejection under 35 U.S.C. §103(a). Furthermore, Applicants respectfully submit that currently amended claim 1 is allowable for several additional reasons. Therefore, Applicants hereby request withdrawal of the rejection, followed by allowance of claim 1.

**Claim 4**

Because independent claim 1 is allowable, claim 4 that depends directly on claim 1 is also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, Applicants respectfully request allowance of claim 4.

**III. Statement of the Rejection**

Claims 8 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Raynal et al. (“Raynal”) [US 6,643,389] in view of Bohn et al. (“Bohn”) [US 6,207,945] further in view of Akizuki [US 6,360,004].

**Response to the Rejection**

**Claims 8 and 16**

Because independent claim 1 is allowable, claims 8 and 16 that each depend directly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Furthermore, it may be relevant to point out that pertinent remarks have been provided above with reference to the rejection of claim 1, wherein Applicants have provided reasons why the rejection based on a combination of Raynal and Bohn is improper. Because this combination is improper, the further combination of Akizuki is also improper.

For at least the reasons mentioned above, Applicants respectfully request withdrawal of the rejection followed by allowance of claims 8 and 16.

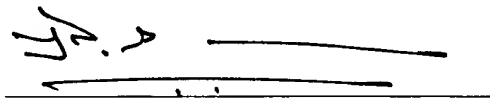
**Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

**CONCLUSION**

In light of the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that all pending claims 1, 3-18 and 22-24 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (404) 610-5689.

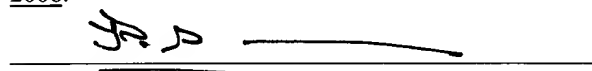
Respectfully submitted,



P. S. Dara  
Reg. No. 52,793

P. S. Dara  
7115 Threadstone Overlook  
Duluth, GA 30097  
(404)-610-5689

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA, 22313-1450, on **19 October 2006**.

  
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Signature  
Name: P. S. Dara